

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. §1.116, are respectfully requested in light of the remarks which follow.

I. Claim Amendments

By the foregoing amendment, claims 1 and 11 have been amended. Support for the amendments to the claims can be found throughout the specification and claims as filed.

The amendments to the claims have been made without prejudice or disclaimer to any subject matter canceled herein. Applicants reserve the right to file one or more continuation and/or divisional applications directed to any canceled subject matter. No new matter has been added, and entry of the foregoing amendments of the above-identified application are respectfully requested.

II. Response to Objections to the Specification

The specification was objected to for allegedly introducing new matter into the disclosure.

In response, Applicant's have submitted herewith a substitute specification cancelling the alleged new matter from the specification. Thus, Applicants respectfully request reconsideration and withdrawal of the objection.

III. Response to Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

At pages 3 and 4 of the Office Action, claims 1-13 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The indefiniteness rejection has been maintained for reasons already of record.

Specifically, the Examiner has stated that the phrase "underlying cause of" renders the claims indefinite. As noted above, this phrase has been deleted from the claims.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

IV. Response to Claim Rejections Under 35 U.S.C. § 102

At pages 4 and 5 of the Office Action, claims 1-14 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by GB 1,578,452 as evidenced by US 5,986,129. This rejection has also been maintained for reasons already of record.

Specifically, the Examiner has stated that the '452 patent discloses a method of treating rheumatoid arthritis and osteoarthritis by administering diacerhein (1,8-deacyl rhein as taught in '129) in a dosage of 50 mg. This rejection is respectfully traversed.

It is well established that for prior art to be anticipatory, every element of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 213 U.S.P.Q. 81, 90 (Fed. Cir. 1986). Applicants submit that the cited reference fails to satisfy this requirement, for at least the following reasons.

To expedite prosecution in the present application, and not to acquiesce to the Examiner's rejection, claim 1 has been amended to recite that said condition is selected from the group consisting of psoriatic arthritis, Wegener's disease, granulomatosis, asthma, pulmonary emphysema, Paget's disease, bone metastases, atherosclerosis, myeloma and myeloid leukemia. Applicants submit that the cited reference does not teach or even suggest treatment of the diseases recited in the present claims.

Since each and every element of Applicant's claimed invention is not taught in GB 1,578,452, the reference fails to anticipate the claims of the present application. Accordingly, Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 102 rejection.

CONCLUSION

It is respectfully submitted that all rejections have been overcome by the above amendments. Thus, a Notice of Allowance is respectfully requested.

In the event that there are any questions relating to this amendment or the application in general, it would be appreciated if the Examiner would contact the undersigned attorney by telephone at (703) 836-6620 so that prosecution of the application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL PC

By: 
Lisa E. Stahl, Ph.D.
Registration No. 56,704

Date: September 17, 2007

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620